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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/982,302 | 10/17/2001 | Keith D. McBrayer | MCBCP0101USA | 7849 |
| 7590 | 10/13/2004 | | | |
| Donald L. Otto Renner, Otto, Boisselle & Sklar, LLP 19th Floor 1621 Euclid Avenue Cleveland, OH 44115-2191 | | | EXAMINER COHEN, AMY R | |
| | | | ART UNIT 2859 | PAPER NUMBER |
| DATE MAILED: 10/13/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,302

Applicant(s)

MCBRAYER, KEITH D.

Examiner

Amy R Cohen

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7-13,19 and 29-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,7-13,19 and 29-39 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palitto (U.S. Patent No. 2,593,914).

Palitto discloses a combination layout tool (7) comprising two triangular shapes wherein each triangular shape forms two 67.5° angles and one 45° angle (Figs. 1-3, two triangles formed along the bisecting line 9).

Palitto does not disclose a combination layout tool comprising one triangular shaped member, with a perpendicular height from one end of said 67.5° angle corners to an opposite side edge in excess of 20 inches and wherein said height is approximately 24 inches.

Regarding claim 1: Palitto discloses the claimed invention as stated above except that the layout tool comprises two triangular shaped members formed as one. It would have been obvious to one of ordinary skill in the art to modify the combination layout tool of Palitto, to break the tool along the bisecting line 9, forming two triangles, each with two 67.5° angle corners and a 45° angle corner, since Palitto discloses the desire to form angles at 67.5° and to form a bisecting line within the layout tool for bisecting the tool into two triangles, each with two 67.5° angle corners and a 45° angle corner (Col 1, lines 45-53 Col 2, lines 7-37, and Col 3, lines 10-19), and since it has been held that constructing a formerly integral structure in various element involves only routine skill in the art. See Nerwin v. Erlichman, 168 USPQ 177, 179.

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See also MPEP 2144.04, section V. *Making Portable, Integral, Separable, Adjustable, or Continuous*.

Regarding the height of the tool: Palitto discloses a combination layout tool where the height is approximately 3 inches. However, to choose a height of 20 inches or 24 inches, absent any criticality, is only considered to be the “optimum” value of the height of the tool, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination tool of Palitto to enlarge it to a size of 20 inches or 24 inches so that a user would be able to use the device for measuring and marking objects which are 20 inches or 24 inches.

Allowable Subject Matter

3. Claims 5, 7-13, 19, 29, 30-39 are allowed.

Reasons for Allowance

4. The following is an examiner’s statement of reasons for allowance:

Claims 11-13, 30: The prior art of reference does not disclose or suggest a combination layout tool comprising at least one rafter tail/ridge cut pattern formed in said one side edge in spaced relation from said notch, said pattern comprising two straight sides intersecting said one side edge and intersecting one another at 90°, one of said sides being shorter than the other side in combination with the remaining limitations of the claims.

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Claims 5, 7-10, 19, and 29: The prior art of record does not disclose or suggest a combination layout tool comprising a triangular shaped member, having a notch in said one side edge, and a plurality of laterally spaced apart elongated incremental angle slots in said member adjacent the side edge of said member opposite said one corner that extend in a direction in radial alignment with said notch in said one side edge, wherein said member has two $67\frac{1}{2}^{\circ}$ corners and one 45° angle corner, in combination with the remaining limitations of the claims.

Claims 31-33: The prior art of record does not disclose or suggest a combination layout tool comprising tread and riser slots in said member extending at 90° relative to one another, said tread and riser slots having inner ends terminating in closely spaced relation from one another and outer ends terminating in a plane parallel to the one side edge in combination with the remaining limitations of the claims.

Claims 34-38: The prior art of record does not disclose or suggest a combination layout tool comprising a plurality of elongated spaced apart parallel stud layout slots in said member extending in a direction perpendicular to said one side edge in combination with the remaining limitations of the claims.

Claim 39: The prior art of record does not disclose or suggest a combination layout tool comprising a hole in said member in the same plane in which the outer ends of said tread and riser slots terminate, said hole being spaced from said outer end of said riser slot a distance corresponding to the distance between the outer ends of said tread and riser slots in combination with the remaining limitations of the claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

5. Applicant's arguments filed 16 August 2004, with respect to claims 1 and 2, have been fully considered but they are not persuasive.

6. In response to applicant's argument that there is no suggestion to break the combination layout tool of Palitto, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner asserts that breaking the device along the bisecting line is in fact, an obvious modification, since it would be easier to have an edge to align with an already drawn bisecting line, instead of holes along the axis of a bisecting line in the tool, and since a line does not have to be previously drawn in order to use the tool, an edge of the device could be used to draw the bisecting line.

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392,

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170 USPQ 209 (CCPA 1971). In this case, Examiner asserts that breaking the device along the bisecting line is in fact, an obvious modification, since it would be easier to have an edge to align with an already drawn bisecting line, instead of holes along the axis of a bisecting line in the tool, and since a line does not have to be previously drawn in order to use the tool, an edge of the device could be used to draw the bisecting line.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

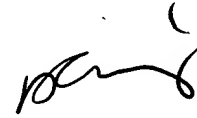
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (571) 272-2238. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARC
October 7, 2004



Diego Gutierrez
Supervisory Examiner
Tech Center 2800